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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLEN TINDAL and JEFFERY A. SCHENK

Appeal 2007-3708
Application 09/730,682
Technology Center 2100

Decided: June 12, 2008

Before JAMES D. THOMAS, LANCE LEONARD BARRY, and THU A.
DANG, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 21-29, 32, and 33. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal enables a network administrator to configure a new network device or reconfigure an existing network device by logging into a network manager unit and selecting a particular device. The unit retrieves a configuration record for the selected device from a common repository and provides that record to the administrator. After receiving the record, the administrator can change fields therein. Next, the unit verifies that the requested changes comply with the policies and rules established for the associated network. Assuming that the changes do not violate any of the policies or rules, the unit updates and stores the modified record in the repository. (Spec. ¶ [012].)

B. ILLUSTRATIVE CLAIMS

Claims 21 and 27, which further illustrate the invention, follow.

21. A method for generating a configuration record for a network device, the method comprising the steps of:

- gathering information from at least one source that uniquely and generically indicates desired capabilities of the network device;

- obtaining actual-configuration data for the network device, wherein the actual-configuration data corresponds to existing capabilities of the network device; and

- altering the actual-configuration data in accordance with the gathered information so as to generate a configuration record for the network device;

- wherein the configuration record represents a physical configuration for the network device that enables the network device to provide the desired capabilities.

27. A method for generating a configuration record for a network device, the method comprising the steps of:

gathering first configuration data from at least one source that uniquely and generically indicates desired capabilities of the network device;

retrieving second configuration data for the network device, the-second configuration data including information about how the network device is currently configured to operate;

generating the configuration record by combining the first configuration data and the second configuration data into a configuration record for the network device,

wherein the configuration record represents a physical configuration for the network device that enables the network device to provide the desired capabilities; and

storing the configuration record in a repository of configuration records.

C. REJECTIONS

Claims 21, 22, 24, 26, and 32 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,764,955 ("Doolan").

Claim 23 stands rejected under 35 U.S.C. § 103(a) as obvious over Doolan and U.S. Patent No. 5,832,503 ("Malik").

Claim 25 stands rejected under § 103(a) as obvious over Doolan and U.S. Patent No. 5,878,432 ("Misheski").

Claims 27, 28, and 33 stand rejected under § 102(b) as anticipated by Malik.

Claim 29 stands rejected under § 103(a) as obvious over Malik and *Common Information Model - A Developer's Perspective* ("IEEE").

II. INITIAL OBSERVATIONS

An appeal brief must include "[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters." 37 C.F.R. § 41.37(c)(1)(v) (2007). Here, spanning six pages (Amended Br. 2-7), the Appellants' *Summary of Claimed Subject Matter* is far from concise. Rather than summarizing their invention, moreover, it basically reiterates paragraphs from the Specification. Furthermore, the *Summary* reads none of the appealed claims on the Specification or any of the Appellants' drawings. Although claims 21-29, 32, and 33 recite methods, moreover, the *Summary* contains no reference to Figure 7, the only drawing of that shows method steps. The Appellants should ensure that their future summaries are more helpful.

Furthermore, the *Summary* contains numerous references to specific line numbers of their Specification. (Amended Br. 3-7.) Although such precision is welcome, the Specification itself omits line numbers. The Appellants should number the lines of their specifications to facilitate reference thereto.

III. CLAIMS 21-26 AND 32

"Rather than reiterate the positions of parties *in toto*, we focus on the issues therebetween." *Ex parte Katsukawa*, No. 2007-0732, 2007 WL 3043602 at *2 (BPAI 2007). The Examiner makes the following findings.

Doolan discloses gathering information from at least one source that uniquely and generically indicates desired capabilities of a network device (see column 12 lines 33-40); obtaining actual-configuration data for the network device, wherein the actual-configuration data corresponds to existing capabilities of the network (see column 12 lines 40-50); and altering the actual-configuration data in accordance with the gathered information so as to generate a configuration record for the network device; wherein the configuration record represents a physical configuration for the network device that enables the network device to provide the desired capabilities and the configuration record generically represents the physical configuration for the network device, and wherein the configuration record is usable to effectuate the physical configuration for the network device that enables the network device to provide the desired capabilities by enabling code that is specific to the network device to be generated and sent to the network device in response to the alteration of the actual configuration data (see column 11 line 65 through column 12 line 32 and column 14 lines 1-24).

(Ans. 3-4.) The Appellants argue, "Doolan simply does [sic] teach anything that enables desired capabilities of a network device to be effectuated by obtaining and altering actual configuration data to generate a configuration record that enables the network device to provide the desired capabilities."

(Reply Br. 7.) Therefore, the issue is whether Doolan discloses acquiring first data and second data and altering the second data in accordance with the first data, thereby generating third data.

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed.Cir. 2003) (internal citations omitted).

A. CLAIM CONSTRUCTION

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "[O]ur reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art." *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (citing *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004)), *aff'd*, 191 Fed. Appx. 959 (Fed. Cir. 2006). "[W]hen descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability." *Mathias*, 84 USPQ2d at 1279 (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)).

Furthermore, "[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed.Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re*

Stencel, 828 F.2d 751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

Here, claim 21 recites in pertinent part the following limitations:

gathering information from at least one source *that uniquely and generically indicates desired capabilities of the network device*;

obtaining *actual-configuration* data for the network device, *wherein the actual- configuration data corresponds to existing capabilities of the network device*; and

altering the *actual-configuration* data in accordance with the gathered information so as to generate a *configuration* record for the network device;

wherein the *configuration* record *represents a physical configuration for the network device* that enables the network device to provide the desired capabilities.

(Emphases added.) Because the italicized phrases "cannot alter how the process steps are to be performed to achieve the utility of the invention" *Mathias*, 84 USPQ2d at 1279, we view the phrases as nonfunctional descriptive material. Therefore, the phrases are not entitled to patentable weight.

Because the clauses "for the network device" and "that enables the network device to provide the desired capabilities" merely state an intended use or purpose for the method for generating a record, moreover, the clauses also are not entitled to patentable weight. Giving the claim its broadest, reasonable construction, therefore, the limitations merely require acquiring

first data and second data and altering the second data in accordance with the first data, thereby generating third data.

B. ANTICIPATION ANALYSIS

"[A]nticipation is a question of fact." *In re Hyatt*, 211 F.3d 1367, 1371-72 (Fed. Cir. 2000) (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)). "A reference anticipates a claim if it discloses the claimed invention 'such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention.*'" *In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995) (quoting *In re LeGrice*, 301 F.2d 929, 936 (CCPA 1962)). Of course, anticipation "is not an 'ipsissimis verbis' test." *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479 n.11 (Fed. Cir. 1986)). "An anticipatory reference . . . need not duplicate word for word what is in the claims." *Standard Havens Prods. v. Gencor Indus.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991).

Here, "[i]nitialization and provision module 318 is typically the first function executed within [Doolan's] gateway." (Col. 12, ll. 59-60.) The module "is used to acquire and manage configuration information which is stored in CFG DATA 320, a configuration database. Configuration information is required to initialize sessions with each legacy network element." (*Id.* ll. 33-37.)

The reference discloses a "structure definition used by the initialization and provisioning module 318 and contained for each legacy network element in CFG DATA 320" (Col. 13, ll. 25-27.) "During initialization, the proper information is filled in the above defined structure." (Col. 14, ll. 3-5.) "If a legacy network element . . . was previously configured, the new information would be considered current and would override the old information. Only one set of configuration information is kept per legacy network element." (*Id.* ll. 19-23.)

We find that Doolan's acquiring of new information and old information teaches the claim's acquiring of first data and second data, respectively. We also find that the reference's overwriting the old information with the new information, thereby generating the current configuration information, teaches the claim's altering the second data in accordance with the first data thereby generating third data. Therefore, we affirm the rejection of claim 21.

The Appellants' treatment of claims 22, 24, 26, and 32 is based on their aforementioned argument (Amended App. Br.¹ 13-16) or on nonfunctional descriptive material. (*Id.* 16.) Unpersuaded by this argument and unpersuaded that the material is entitled to patentable weight, we also affirm the rejections of these claims.

¹ We rely on and refer to the Amended Appeal Brief, in lieu of the original Appeal Brief, because the latter was defective. We have not considered the original in deciding this appeal.

The Appellants do not challenge the rejection of claims 23 or 25 individually (*id.* 8), thereby relying on their aforementioned argument. Unpersuaded by this argument, we also affirm the rejections of these claims.

IV. CLAIMS 27-29 AND 33

The Examiner finds that "in column 2 lines 21-24 and column 3 lines 16-20, Malik discloses obtaining values of certain attributes by interrogating the model and captures values for the attributes defined in the template." (Ans. 14.) The Appellants argue that their "first configuration data and second configuration data are clearly distinct: the former 'indicates desired capabilities' and the latter 'including information about how the network device is currently configured to operate'" (Amended App. Br. 19.) Therefore, the issue is whether Malik discloses acquiring first data and second data and combining the first data and second data, thereby generating third data.

A. CLAIM CONSTRUCTION

Claim 27 recites in pertinent part the following limitations:

gathering first *configuration* data from at least one source *that uniquely and generically indicates desired capabilities of the network device*;

retrieving second *configuration* data for the network device, *the-second configuration data including information about how the network device is currently configured to operate*;

generating the *configuration* record by combining the first *configuration* data and the second *configuration* data into a *configuration* record for the network device

Because the italicized phrases "cannot alter how the process steps are to be performed to achieve the utility of the invention," *Mathias*, 84 USPQ2d at 1279, we view the phrases as nonfunctional descriptive material. Therefore, the phrases are not entitled to patentable weight.

Because the clause "for the network device" merely states an intended use or purpose for the method for generating a record, moreover, the clause also is not entitled to patentable weight. Giving the claim its broadest, reasonable construction, therefore, the limitations merely require acquiring first data and second data and combining the first data and second data, thereby generating third data.

B. ANTICIPATION ANALYSIS

Malik's "configuration manager enables a user to create configurations with a template. A template is a list of attributes for a device" (Col. 3, ll. 26-28.) "The user . . . selects the attributes needed for the template, which depending on the purpose of the template, might include . . . dozens of attributes." (*Id.* ll. 32-35.) "The configuration manager then captures the values of the attributes listed in the template, by retrieving the values from the SPECTRUM model." (*Id.* ll. 36-38.) We find that the reference's capturing of some of the values of the attributes listed in the template teaches the claim's acquiring of first data, and the reference's capturing of some of the other values of the attributes listed in the template teaches the claim's acquiring of second data.

Malik discloses that "[t]he resulting configuration created with the template contains the attributes from the template and the values collected from the model. The configuration may be stored in the configuration manager, in another storage device, or the SPECTRUM database." (*Id.* 42-46.) We find that the reference's combining captured values in a "configuration" teaches the claims' combining the first data and second data, thereby generating third data. Therefore, we affirm the rejection of claim 27.

The Appellants do not challenge the rejection of claim 29 individually (*id.* 8), thereby relying on their aforementioned argument. Unpersuaded by this argument, we also affirm the rejections of this claim.

The Appellants' treatment of claims 28 and 33 is based on their aforementioned argument (*id.* 20-22) or on nonfunctional descriptive material. (*Id.* 22.) Unpersuaded by this argument and unpersuaded that the material is entitled to patentable weight, we also affirm the rejections of these claims.

V. ORDER

In summary, the rejections of claims 21-29, 32, and 33 are affirmed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii).

Accordingly, our affirmance is based only on the arguments made in the Amended Appeal Brief and Reply Brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rwk

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